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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,543	11/21/2000	Fenyong Liu	BERK-005	2657

7590 02/28/2002

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EXAMINER

NGUYEN, QUANG

ART UNIT PAPER NUMBER

1636

DATE MAILED: 02/28/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,543

Applicant(s)

LIU ET AL.

Examiner

Quang Nguyen

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-26, drawn to an antiviral polynucleotide ligand composition and a method of treating viral infection using the same, classified in class 514, subclass 44.
- II. Claims 27-32, drawn to a method of selecting a polynucleotide ligand having antiviral activity, classified in class 435, subclass 6.

Should Group I be elected, further **group restriction** is required because claims 8 and 21 comprise a plurality of disclosed patentably distinct groups of polynucleotide sequences having antiviral activity that lack the unity of invention. The following groups of polynucleotide sequences have no common core structure or elements:

- (1) SEQ ID NOs: 1-6;
- (2) SEQ ID NOs: 7-11;
- (3) SEQ ID NOs: 12-16;
- (4) SEQ ID NO: 17;
- (5) SEQ ID NO: 18;
- (6) SEQ ID NO: 19;
- (7) SEQ ID NO: 20;
- (8) SEQ ID NO: 21;

- (9) SEQ ID NO: 22;
- (10) SEQ ID NO: 23;
- (11) SEQ ID NO: 24;
- (12) SEQ ID NO: 25;
- (13) SEQ ID NO: 26;
- (14) SEQ ID NO: 27;
- (15) SEQ ID NO: 28;
- (16) SEQ ID NO: 36;
- (17) SEQ ID NO: 37;
- (18) SEQ ID NO: 38;
- (19) SEQ ID NO: 39;
- (20) SEQ ID NO: 40;
- (21) SEQ ID NO: 41;

Claims 1-7, 12-20 and 25-26 link a plurality of the above patentably distinct groups of polynucleotide sequences having antiviral activity. The restriction requirement between linked inventions is subject to the non-allowance of the linking claims 1-7, 12-20 and 25-26. The restriction requirement between linked inventions is subject to the non-allowance of the linking claim(s), 1-7, 12-20 and 25-26.

Upon the allowance of the linking claims, the restriction requirement as to the linked invention shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s)

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depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims or the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-132(CCPA 1971). See also MPEP 804.01.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are drawn to mutually exclusive and independent methods. Invention I is drawn to a method of treating viral infection using an antiviral polynucleotide ligand composition whereas Invention II is directed to a method of selecting a polynucleotide ligand having antiviral activity. The methods require separate and distinct protocols, method steps and desired end-results and they are involved different technical considerations for achieving the end results.

Further group restriction is required because claims 8 and 21 recite a plurality of disclosed patentably distinct groups of polynucleotide sequences having antiviral activity that have no common core structure or elements, and therefore they lack the unity of invention. Additionally, because of limited resources from the US PTO to conduct the computer search of the claimed SEQ ID NOs, and all of the SEQ ID NOs do not possess a common core structure or element, an undue burden would be needed to search and examine all of the claimed inventions in a single application, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and separate search requirements, it would be unduly burdensome for the examiner to search and/or consider the patentability of all the inventions in a single application. Therefore, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17 (h).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang Nguyen, Ph.D., whose telephone number is (703) 308-8339.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's mentor, Dave Nguyen, may be reached at (703) 305-2024, or SPE, Irem Yucel, at (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tracey Johnson, whose telephone number is (703) 305-2982.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1636.

Quang Nguyen, Ph.D.


DAVE T. NGUYEN
PRIMARY EXAMINER